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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

EDELMAN, BRADLEY E

ART UNIT PAPER NUMBER

2153

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,927

Applicant(s)

SCHMIDT, CHRISTOPHER

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a first Office action on the merits of this application. Claims 1-63 are presented for examination.

Specification

1. The disclosure is objected to because of the following informalities: The references to certain provisional and non-provisional patent applications on page 2 of the specification needs to be updated with current application numbers.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4, 20, 35, and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims all describe that a tag includes "spectral" information corresponding to proprietary content. However, the specification fails to provide a definition for "spectral" and fails to disclose how such "spectral" information is obtained

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or used. Therefore, the feature of including "spectral" information is not enabled by the specification.

Claims 4, 20, 35, and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter (i.e. "spectral" information) which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application gives no description of what type of spectral information is contemplated by such language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stebbings (U.S. Patent No. 6,564,253).

In considering claim 1, Stebbings discloses a method of controlling transfer of proprietary content on a computer network comprising the steps of:

identifying computers offering proprietary content on the computer network;
identifying network addresses corresponding to the computers (domain server address or user's modem telephone number);

identifying physical addresses corresponding to the network addresses (user's home or other unique identifier); and

taking action based on such identification ("a report may be issued" and "specific action may be taken," col. 9, lines 36-47).

However, Stebbings remains silent regarding what types of actions can be taken as a result of discovering unauthorized use of proprietary information. Thus, Stebbings leaves open the possibility of using any well known method of taking such action. Examples of well-known ways to take action upon discovering copyright violation include sending a message (electronic or physical) to the violator, sending a message to an administering agency regarding the illegal use, and numerous other actions. Thus, it would have been obvious to a person having ordinary skill in the art for the action taught by Stebbings to include sending a warning to the physical address of the copyright violator, in order to make the violator stop distributing or using illegal copies of the proprietary information.

In considering claim 2, Stebbings further discloses generating a tag ("flag") corresponding to the proprietary content.

In considering claim 3, Stebbings further discloses comparing the tag to other tags (col. 10, lines 3-34, inherent in the step of analyzing the received tag and determining what values it corresponds to). Although Stebbings does not disclose that the other tags are stored in a database of tags, databases are well known structures for

storing data, and it would have been obvious to store such tags in a database, because databases provide for easy access and structured organization to information.

In considering claim 4, Examiner has interpreted the term "spectral information" as simply meaning "information." Thus, the tags taught by Stebbings further disclose that the tags include information corresponding to the proprietary content (i.e. "levels of authorization," col. 10, lines 10-27).

In considering claim 5, Stebbings further discloses identifying owners of the network addresses (i.e. "user," or "domain," col. 9, lines 45-46).

In considering claim 6, Stebbings further discloses issuing reports including network addresses (col. 9, lines 44-46). Although Stebbings does not explicitly state that the addresses are stored in a database, the addresses would have to be stored somewhere to allow an administrator or copyright holder to analyze who has been pirating his or her works. Databases are a well-known structure for storing information. Thus, it would have been obvious to store the reported information in a database, because databases provide for easy access and structured organization to information.

In considering claim 7, it would have been further obvious to remove duplicate network addresses from the database in order to conserve storage space.

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In considering claims 8 and 9, Stebbings further discloses that the proprietary content includes music or a movie (col. 8, lines 14-16).

In considering claim 10, although Stebbings focuses on movies and music, and does not discuss distributing electronic books, Examiner takes official notice that electronic books or portions thereof can also be distributed across the Internet. Thus, given the teaching of Stebbings, it would have been obvious to a person having ordinary skill in the art to protect and monitor electronic books in the same way that Stebbings teaches for movies and music, so that owners of copyrights in books can receive sufficient compensation for their electronically sold works.

In considering claim 11, Stebbings further discloses that the proprietary content includes an image (an image is part of a movie).

In considering claim 12, as discussed with regard to claim 1, sending a warning letter, such as a cease and desist letter, is just one well-known method of taking action upon discovering that a user is pirating proprietary information. Thus, it would have been obvious to a person having ordinary skill in the art to send cease and desist letters to users who illegally copy proprietary information as a way of making them stop their illegal activities.

In considering claims 13 and 14, as discussed with regard to claim 1, sending messages either by physical mail or electronically is well known and would have been an obvious way of sending a warning to a user who illegally copies proprietary information.

In considering claim 15, Stebbings further discloses that the network is the Internet (Abstract).

In considering claim 16, Stebbings further discloses that the computers are part of a peer-to-peer file sharing network (col. 9, lines 36-48, wherein users use chat room and share music files across the network).

In considering claim 17, Stebbings discloses a method of identifying violators of property rights on a computer network comprising the steps of:

Continuously identifying computers offering proprietary content on the computer network, and identifying network addresses corresponding to the computers (col. 9, lines 36-48, "searching the Internet" to find unauthorized copies of proprietary information, and reporting the "domain server address," "user," or "modem telephone number").

Although Stebbings does not explicitly describe storing the network addresses in an updatable network address database, Stebbings does disclose issuing "reports" including such network address information. Furthermore, the addresses would have to

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be stored somewhere to allow an administrator or copyright holder to analyze who has been pirating his or her works. Because databases are well-known structures for storing large amounts of information, it would have been obvious to store the reported information in a database, to provide for easy access to and structured organization of the information.

Claims 18-21, 22, and 23-31 contain the same limitations as respective claims 2-5, 7, and 8-16 and are thus rejected for the same reasons.

Claim 32 presents a system comprising means for performing the method of claim 1, and is thus rejected for the same reason as claim 1.

Claims 33-35, 37, 38, and 39-47 contain the same limitations as respective claims 2-4, 5, 7, and 8-16 and are thus rejected for the same reasons.

In considering claim 36, Stebbings further discloses means for identifying user names corresponding to the computers (i.e. user's unique identification, col. 9, lines 45-47).

Claims 48-62 present no further limitations over the claims already discussed, and are thus rejected for the same reasons.

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Claim 63 presents a computer program product for performing the same steps claimed in claim 1, and is thus rejected for the same reasons.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is 571-272-3953. The examiner can normally be reached from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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November 4, 2004